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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/242,772 06/25/99 VAN DE VEN W 702-990278

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PITTSBURGH PA 15219-1818

HM12/0114

EXAMINER

WILDER, C

ART UNIT	PAPER NUMBER
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1655

DATE MAILED:

01/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/242,772

Applicant(s)

Van De Ven, W. et al.

Examiner

CB Wilder

Group Art Unit

1655



☒ Responsive to communication(s) filed on Oct 7, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 26-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 26-46 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1655

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1 because the special technical feature, the PLAG family genes and CTNNB1 gene, were known in the prior art. Kraus et al. (Genomics. Volume 23, pages 272-274, December 1994) discloses the localization of human CTNNB1 to chromosome 3. Nollet et al. (Genomic. Volume 32, pages 413-424, December 1995) discloses the genomic organization of the human beta-Catenin Gene (CTNNB1). Kas et al. (Nature Genetics. Volume 15, pages 170-174, February 1997) discloses activation of the PLAG1 gene and the CTNNB1 gene. DiBello et al. (Genetics. Volume 129, pages 385-397, November 1991) discloses a family of related proteins containing zinc fingers.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 26-33, drawn to an isolated nucleic acid

Group II, claim(s) 33-35, drawn to macromolecule.

Group III, claim (s) 36-38, 41, 42, 44 and 45, drawn to a nucleic acid assay.

Group IV, claim(s) 39 and 40, drawn to an *in situ* diagnostic method.

Group V, claim 43, drawn to an immunoassay.

Art Unit: 1655

Group VI, claim(s) 45, drawn to a method of identifying a T-gene.

Group VII, claim(s) 46, drawn to a method of inhibiting a T-gene.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group(s) I drawn to an isolated nucleic acid and Group (s) II drawn to a macromolecule lack the same technical feature since they are products with different structure and biological properties, specifically, proteins and antibodies in Group II vs. Nucleic acids in Group I.

Group(s) III-VII lack the same technical feature since they are drawn to distinct methods which differ in the method objectives, method steps and in the reagents used.

A 371 case is considered to have unity of invention only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" means those technical features that define a contribution which each of the claimed invention as a whole, makes over the prior art. While the instant claims all involve the isolated nucleic acid, it is clear from Groups I-VII that said isolated nucleic acid does not define a contribution over the prior art because it was known as disclosed by the references mentioned above.

Because these invention are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and because the literature

Art Unit: 1655

searches for examination of the groups identified above are not coextensive, restriction for examination purpose as indicated is proper.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1, wherein the special technical feature was known in the prior art.

Claim 34 contains the following species:

- (a) a nucleic acids
- (b) a protein
- (c) an antibody

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1655

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species of group (a-c) lack the same or corresponding special technical features since the species have different chemical compositions and different biological properties.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Friday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed the Group's receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/242,772

Page 6

Art Unit: 1655

Cynthia B. Wilder

Cynthia B. Wilder, Ph.D.

January 6, 2000

S. Zimer

STEPHANIE W. ZIMMER
PRIMARY EXAMINER